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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,050	01/25/2002	Henry Ji	25436/1124	5500
27495	7590	03/11/2004	EXAMINER	
PALMER & DODGE, LLP KATHLEEN M. WILLIAMS / STR 111 HUNTINGTON AVENUE BOSTON, MA 02199			ZARA, JANE J	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/057,050

Applicant(s)

JI ET AL.

Examiner

Jane Zara

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 4, 5 and 6, drawn to a method of molecular cloning, classifiable in class 435, subclass 6.
- II. Claims 2-5, drawn to a method of forming a ligated molecule, classifiable in class 435, subclass 6.
- III. Claims 7-10, 13-16, drawn to a method of molecular cloning wherein one end of a linear arm comprises a cloning substrate site, classifiable in class 435, subclass 6.
- IV. Claims 7, 8, 11, 17, drawn to a method of molecular cloning wherein the cloning substrate site is a site for homologous recombination, classifiable in class 435, subclass 6.
- V. Claims 7, 12 and 18, drawn to a method of molecular cloning wherein left and right arms comprise lambda arms and covalently bound topoisomerase, classifiable in class 435, subclass 6.
- VI. Claims 19-22, 24 drawn to a method of molecular cloning comprising a first linear arm with covalently bound topoisomerase and a cloning substrate site, and a second linear arm with a ligase substrate site and a cloning substrate site, classifiable in class 435, subclass 6.

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- VII. Claims 19, 23, drawn to a method of molecular cloning comprising a first linear arm with covalently bound topoisomerase and a homologous recombination cloning substrate site, and a second linear arm with a ligase substrate site and a cloning substrate site, classifiable in class 435, subclass 6.

Please elect a single cloning substrate site in the elected Group.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II and III and IV and V and VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions comprise biologically and functionally different and distinct Groups and thus one does not render the other obvious. The methods of Groups I-VII comprise steps which are not required for or present in the methods of the other groups: a method of molecular cloning (Group I), a method of forming a ligated molecule (Group II), a method of molecular cloning wherein one end of a linear arm comprises a site specific cloning substrate site (Group III), a method of molecular cloning wherein one end of a linear arm comprises a homologous recombination cloning substrate site (Group IV), a method of molecular cloning wherein left and right arms comprise lambda arms and covalently bound topoisomerase (Group V), a method of molecular cloning comprising a first linear arm

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with covalently bound topoisomerase and a cloning substrate site and a second linear arm with a ligase substrate site and a site specific cloning substrate site (Group VI), and a method of molecular cloning comprising a first linear arm with covalently bound topoisomerase and a homologous recombination cloning substrate site, and a second linear arm with a ligase substrate site and a cloning substrate site (Group VII).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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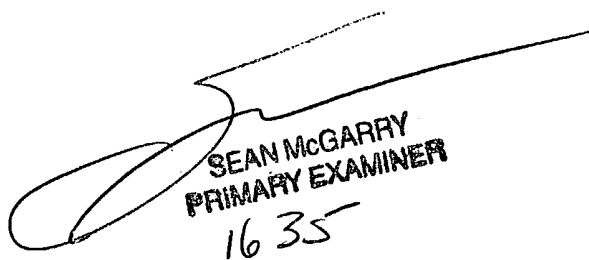
### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is **703-872-9306**. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(571) 272-0765**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (571) 272-0760. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

**JZ**

January 30, 2004

  
SEAN MCGARRY  
PRIMARY EXAMINER  
1635